

**Amendments to the Drawings**

The attached sheet of drawings include changes to Figs. 1-2. This sheet, which includes Figs. 1-2, replaces the original sheet including Figs. 1-2.

Attachment: Replacement Sheet

### **Remarks/Arguments**

Claims 5-30 are pending. Claims 5, 11, 17, and 23 have been amended. Reconsideration of this application in light of the foregoing amendments and following remarks is requested.

#### Objections to the Drawings

Applicant has incorporated the Examiner's requested changes into Figs. 1 and 2 of the drawings.

#### Rejections under 35 U.S.C. § 101

Claims 23-26 have been rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant has amended claim 23 and submits that claims 23-26 are now in compliance with 35 U.S.C. § 101.

#### Rejections under 35 U.S.C. § 112, First Paragraph

Claim 5 was rejected under 35 U.S.C. § 112, First Paragraph as failing to comply with the written description requirement. Applicant respectfully traverses and directs the Examiner's attention to the originally filed specification at lines 180-196 as one example of support for the amendments to claim 5.

#### Rejections under 35 U.S.C. § 103

Independent claims 5, 11, 17, 23, and 27 were rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 6,490,632 to Vepa ("Vepa") in view of U.S. Patent No. 6,137,802 to Jones ("Jones"). Applicant has amended claims 5, 11, 17, and 23 and now traverses the rejections on the grounds that the cited references are defective in establishing a prima facie case of obviousness with respect to claims 5, 11, 17, 23, and 27.

A. Combination of references fails to teach or suggest all claim limitations

As provided in MPEP § 2143, “[t]o establish a prima facie case of obviousness, ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Furthermore, under MPEP § 2142, “[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claims 5-10

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Jones. It is submitted that, in the present case, the examiner cannot factually support a prima facie case of obviousness because even when combined, the references do not teach the claimed subject matter.

Claim 5 has been amended and now recites in part, “assigning a network adapter, wherein the network adapter is based on a first data link layer network access technology as a primary network adapter... detecting an active network adapter, wherein the active network adapter is based on the second data link layer network access technology,” (emphasis added). This is neither taught nor suggested by Vepa or Jones, nor by their combination.

Regarding this issue, the Examiner has stated that this limitation would have been an obvious modification to the system disclosed by Vepa as evidenced by Jones. However, Jones teaches only “a media switching apparatus [that] automatically switches between wired and wireless service mediums,” (emphasis added) as opposed to first and second data link layer network access technologies. For this reason, at least, a prima facie case of obviousness cannot be made and claim 5 should be allowable. Claims 6-10 depend from and further limit claim 5 and should therefore also be allowable.

Claims 11-16

Claim 11 also stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Johnston. Claim 11 has been amended and now recites in part, “utilizing the first data link layer network access technology for executing the active network application; and selecting the second data link layer network access technology for continuing the active network application,” (emphasis added). This is neither taught nor suggested by Vepa or Jones, nor by their combination.

Regarding this issue, the Examiner has stated that this limitation would have been an obvious modification to the system disclosed by Vepa as evidenced by Jones. However, Jones teaches only “a media switching apparatus [that] automatically switches between wired and wireless service mediums,” as opposed to first and second data link layer network access technologies. For this reason, at least, a prima facie case of obviousness cannot be made and claim 11 should be allowable. Claims 12-16 depend from and further limit claim 11 and should therefore also be allowable.

Claims 17-22

Claim 17 also stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Johnston. Claim 17 recites in part, “means for assigning a network adapter based on a first data link layer network access technology as a primary network adapter; means for detecting an active network adapter based on a second data link layer network access technology,” (emphasis added). This is neither taught nor suggested by Vepa or Jones, nor by their combination.

Regarding this issue, the Examiner has stated that this limitation would have been an obvious modification to the system disclosed by Vepa as evidenced by Jones. However, Jones teaches only “a media switching apparatus [that] automatically switches between wired and wireless service mediums,” as opposed to first and second data link layer network access technologies. For this reason, at least, a prima facie case of obviousness cannot be made and claim 17 should be allowable. Claims 18-22 depend from and further limit claim 17 and should therefore also be allowable.

Claims 23-26

Claim 23 also stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Johnston. Claim 23, as amended, recites in part, “switching between two different data link layer network access technologies on a networked hardware platform without interrupting an active network application,” (emphasis added). This is neither taught nor suggested by Vepa or Jones, nor by their combination.

Regarding this issue, the Examiner has stated that this limitation would have been an obvious modification to the system disclosed by Vepa as evidenced by Jones. However, Jones teaches only “a media switching apparatus [that] automatically switches between wired and wireless service mediums,” as opposed to first and second data link layer network access technologies. For this reason, at least, a prima facie case of obviousness cannot be made and claim 23 should be allowable. Claims 24-26 depend from and further limit claim 23 and should therefore also be allowable.

Claims 27-30

Claim 27 also stands rejected under 35 U.S.C. § 103(a) as being rendered obvious by Vepa in view of Johnston. Claim 27 recites in part, “switching between at least first and second network adapters using first and second Open Systems Interconnect 7-Layer (OSI-7) network access technologies.” This is neither taught nor suggested by Vepa or Jones, nor by their combination.

Regarding this issue, the Examiner has stated that this limitation would have been an obvious modification to the system disclosed by Vepa as evidenced by Jones. However, Jones teaches only “a media switching apparatus [that] automatically switches between wired and wireless service mediums,” as opposed to first and second Open Systems Interconnect 7-Layer (OSI-7) network access technologies. For this reason, at least, a prima facie case of obviousness cannot be made and claim 27

should be allowable. Claims 28-30 depend from and further limit claim 27 and should therefore also be allowable.

B. There is no motivation to combine the references

Furthermore, even if the combination of references cited by the Examiner taught or suggested each element of each claim (which it clearly does not, as described above), the case law is clear that there must be evidence that a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. It is also clear that a rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000) (emphasis added). Applicant submits that the Examiner has submitted no evidence or particular findings to support his conclusion as required.

Additionally, although Applicant strongly disagrees that the combination of references teaches or suggests each claim, even if it did, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP § 2143.01. "A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01 (emphasis original). Here, not only has the Examiner stated no objective reason to combine the references, but the references fail to even show all aspects of the claimed invention as required.

Therefore, the combination of references is improper and claims 5-30 are allowable over the cited art.

**Conclusion**

All rejections having been addressed, all pending claims should now be in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 16, 2005.

*Karen L. Underwood*